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D. REMARKS

Status of Claims

Claims 1-7, 9-14, 16-20, and 22-23 are currently pending in the application. Claims 7, 9, 10, 17, 20 and 23 are amended and claims 8, 15 and 21 are canceled.

Summary of the Interview

Applicants conducted a telephone interview on February 13, 2006. Applicants' representative, Amy Pattillo, and Examiner Nguyen participated in the interview. No demonstrations were made or exhibits shown.

First, Applicants' representative requested clarification of the rejection of claim 1 under 102(e) as allegedly anticipated by Goldhaber (US Patent 5,855,008). Applicants requested that the Examiner point to the portions of Goldhaber relied upon in the rejection of the element "a first network entity" and of the element "sending the edited personal information from the client computer system to each of the selected ones of the at least one other network entity." The Examiner stated that col. 7 of Goldhaber provides an example of a user logging into a system, which reads on a first network entity and the server logged into reads on a second network entity that receives the personal information. Applicants' representative argued that the Examiner's interpretation of Goldhaber does not show how Goldhaber teaches each of a client computer system, a first network entity, and a second network entity and in particular does not teach a client computer system that sends the personal information to the second or at least one other network entity.

Next, Applicants' representative proposed an amendment to claim 7. The Examiner indicated that additional review of the references would be required in view of the proposed amendment and would not make a statement as to allowance.

In addition, Applicants argued that the Examiner does not cite references that teach each element of claim 3. Claim 3 is rejected under 103(a) as allegedly obvious under Goldhaber in view of O'Neil (US Patent 5,987,440). Applicants' representative
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argued that claim 3 teaches "digital watermarking" and that the public-key cryptography and digital signatures described in O'Neil do not teach "digital watermarking." The Examiner agreed that "digital watermarking" is not equivalent to digital signatures, but argued that because O'Neil teaches different versions of digital signatures based on who is receiving the message, the digital signatures of O'Neil read on the digital watermarking of claim 3. Applicants also argued that the Examiner's proposed modification of O'Neil and then Goldhaber by O'Neil is not supported by motivation or suggestion for such modification within the references themselves.

In conclusion, no agreements were made with respect to the claims. Applicants file this response and request further consideration of the claims.

Specification Objection

The Examiner objects to the abstract of the disclosure because of undue length (210 words). [Office Action, pp. 1, 2] The Examiner notes that the required length for the abstract is 110 words or less. Applicants amend the abstract to 93 words. Applications respectfully request withdrawal of the objection to the specification in view of the amended abstract and allowance of the claims.

112 rejection

The Examiner rejects claim 10 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner states that "claim 10 recites the limitation "second renumeration" on page 25, line 17. There is insufficient antecedent basis for this limitation in the claims as a first renumeration is not aforementioned in the independent claim." [Office Action, p. 2] Applicants amend claim 10 to cancel the limitation "second". Because claim 10 only refers to "renumeration", Applicants respectfully assert that regardless of whether the Examiner's previous assertion was correct, claim 10 is definite and particularly points out and distinctly claims the subject matter which application regards as the invention. Therefore,

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Applicants respectfully request withdrawal of the 112 rejection and allowance of claim 10.

Lack of Anticipation under 35 USC § 102(b)

Claims 1, 2, 5-12, 14-18, and 20-23 are not anticipated by Goldhaber

Claims 1, 2, 5-12, 14-18, and 20-23 stand rejected under 35 U.S.C. §102(b) as being anticipated by Goldhaber et al. (US Patent 5,855,008)(hereinafter referred to as Goldhaber). [Office Action, p. 3] The rejection is respectfully traversed as follows. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed Cir. 1987). Furthermore the reference must be an enabling disclosure of each and every element as set forth in the claim. *In re Hoecksma*, 158 USPQ 596, 600 (CCPA 1968); *In re LeGrive*, 133 USPQ 365, 372 (CCPA 1962). Because Goldhaber does not teach each and every element of claims 1, 2, 5-12, 14-18, and 20-23 or enable each and every element of these claims, these claims are not anticipated, the rejection should be withdrawn, and the claims should be allowed.

Claim 1

Claim 1 reads:

1.(Original) A method for controlling personal information of a user using a client computer system enabled to be communicatively connected to a plurality of network entities in a network environment, comprising:
 storing personal information of the user at the client computer system;
 receiving a request from a first network entity to send the personal information stored at the client to at least one other network entity;
 enabling the at least one other network entity to be selectable by the user;
 enabling the personal information to be edited; and
 sending the edited personal information from the client computer system to each of the selected ones of the at least one other network entity.

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In the rejection of claim 1, the Examiner cites Goldhaber, col. 7, lines 11-67, col. 12, lines 49-67, col. 19, lines 22-67, and col. 20, lines 1-58 as disclosing each of the elements of claim 1, without delineating which of the citations disclose each of the elements of claim 1. [Office Action, p. 3] During the Interview, as previously noted, Applicants requested that the Examiner point to the portions of Goldhaber relied upon in the rejection of the element "a first network entity" and of the element "sending the edited personal information from the client computer system to each of the selected ones of the at least one other network entity." The Examiner stated that col. 7 of Goldhaber provides an example of a user logging into a system, which reads on a first network entity and the server logged into reads on a second network entity that receives the personal information.

Applicants respectfully assert that Goldhaber does not teach or enable each and every element of claim 1 because Goldhaber does not teach or enable receiving a request from a first network entity to send the personal information stored at the client to at least one other network entity or sending the edited personal information from the client computer system to each of the selected ones of the at least one other network entity. When claim 1 is viewed as a whole, claim 1 teaches each of a client computer system, a first network entity, and at least one other network entity. The personal information is stored at the client computer system. The client computer system receives a request from a first network entity to send the personal information to at least one other network entity. The personal information is sent from the client computer system to the at least one other network entity.

In general, Goldhaber describes "an approach for distributing advertising and other information over a computer network." *Goldhaber*, abstract. Goldhaber describes an "attention brokerage" system or service that provides the "link between the ad and the appropriate viewer" where the "attention brokerage" system providing the link maintains a database of profiles of potential viewers and "protects member privacy while at the same time maintaining the personal information files that permit specialized

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targeting of ads." *Goldhaber*, col. 6, lines 28-35. Col. 7, lines 11-17 of *Goldhaber* describes the "attention brokerage" system implements "a two step technique for the development of an accurate consumer profile. First, a consumer is asked to pro-actively describe him or herself. This forms a "base profile." Then the consumer's actions can be monitored in this example such that a representation of the consumer's actions are "overlaid" upon the self description." Col. 7, lines 28-32 of *Goldhaber* describe that "upon logging into her customized home page, Cynthia would be presented with a list of ads that she may elect to view. The ads would be preselected for her on the basis of a personal profile questionnaire that she has completed plus automatic tracking of her previous internet usage." In addition, Col. 7, lines 48-67 of *Goldhaber* describe:

Next to some of the titles on the ad list displayed to Cynthia is the image of a little gold coin--a "consumer interface button" or "CyberCoin"--with a distinctive style. When Cynthia clicks her mouse on the CyberCoin, it opens up the ad and simultaneously causes a transfer of cash or credit directly to Cynthia's desktop (or to a specialized account, credit card or bank account associated with her). This gives Cynthia an important incentive to watch the ad. The ad can include some degree of interactivity (e.g., Forty-Niners game stadium seating preference, choice of diet dessert, etc.) to allow the service to give the advertiser a guarantee that Cynthia paid attention to the ad. This interactivity can make the ad more fun (e.g., by providing a guessing game, quiz or joke).

The ad might ask Cynthia if she is interested in having the merchant contact her directly, and can include another CyberCoin that compensates Cynthia for the informing the merchant of her identity. Cynthia can be given the choice of whether her identity is to be released--thereby protecting her privacy.

First, with respect to the example in col. 7 of *Goldhaber*, Applicants respectfully assert that where *Goldhaber* describes a user "logging into her customized home page", *Goldhaber* describes the interface for the user logging into the "attention brokerage" system, which is a first network entity. *Goldhaber* only describes the attention broker system that accesses and stores a personal profile for a user and sends the personal profile to advertisers if authorized; by the user; *Goldhaber* does not teach a client

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system that receives a request from an attention broker system for the client system to send personal information stored at the client system to advertisers. In contrast, claim 1 teaches receiving a request at the client system from the first network entity to send personal information to at least one other network entity and sending the information from the client system to the at least one other network entity.

Second, even if , as asserted by the Examiner, the login web page were considered the first network entity and the "attention brokerage" system another network entity, the web page would then be an interface for passing information to the "attention brokerage" system. Therefore, even under the Examiner's assertions, Goldhaber still does not teach each element of claim 1 where the Examiner argues that the attention broker system reads on the other network entity because Goldhaber would not teach or enable sending the personal information stored at the client system directly from the client system to the attention brokerage system.

Goldhaber, col. 12, lines 50-67, as cited by the Examiner, describes an example statement that the attention brokerage system displays to the user to give notice that once the user provides the attention brokerage system with personal information, the service will not release the information to an advertiser unless the user authorizes the service to send the information. Thus, col. 12, lines 50-67 of Goldhaber confirm that the attention brokerage system is the system that passes personal information to advertisers; Goldhaber does not teach the client system receiving a request from the attention brokerage system for the client system to send the personal information to another network entity.

In addition, col. 19, lines 22-67 describes network accessible "trading houses" that attempt to sell information to willing buyers. Goldhaber describes that the consumer has a software agent at the client system that stores the user's personal information and is programmed to determine which trading houses have advertising that matches the user's instructions and to retrieve the matching advertising from the associated trading house. Thus, even in the "trading houses" model of Goldhaber, the client system does not store the personal information and therefore the client system

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also does not receive a request from a first network entity to send the stored information to at least one other network entity or send the information from the client system to at least one other network entity.

Therefore, because Goldhaber does not teach or enable a client system with the stored personal information, a first network entity that requests that the client system send the information, and at least one other network entity that the client system sends the personal information to, Goldhaber does not teach or enable each and every element of claim 1. Because each and every element of claim 1 is not taught by Goldhaber, Goldhaber does not anticipate claim 1 and therefore claim 1 should be allowed.

Claims 2, 5, 6

Applicants respectfully assert that because Goldhaber does not anticipate claim 1, Goldhaber also does not anticipate claims 2, 5, and 6 which are dependent upon claim 1. In addition, Applicants respectfully assert, separately, that Goldhaber does not teach each and every element of claim 2.

Claim 2 reads:

2. (Original) The method of claim 1 wherein enabling the personal information to be edited further comprises enabling the personal information to be separately edited for each selected ones of the at least one other network entity.

The Examiner rejects claim 2 as allegedly disclosed in Goldhaber, col. 12, lines 49-67, col. 13, lines 38-59, and col. 18, lines 1-15. [Office Action, p. 3] Applicants respectfully assert that Goldhaber does not teach or enable each and every element of claim 2 because Goldhaber does not disclose enabling editing of the personal information stored at the client system or enabling editing of the personal information for each of the selected ones of the at least one other network entities that user selects for the client system to send the personal information.

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In particular, Col. 12, lines 49-67 of Goldhaber describes the statement displayed to users that the attention broker server will maintain personal information in confidentiality unless the user authorizes the attention broker server to release the information to an advertiser. Col. 13, lines 38-59 of Goldhaber describes that the attention broker server keeps "a personal profile for each of our members", the user can edit or update the profile maintained by the attention broker server at any time, and that the attention broker server will not release the information to advertisers without the user's content. Col. 18, lines 1-15 of Goldhaber describe a profile entry for a particular user within a profile database maintained by the attention broker server; if the user profile changes then the attention broker server may re-index the profile and perform a new scan for matching ads.

Therefore, as previously asserted with reference to claim 1, Goldhaber does not teach or enable a storing of personal information at a client system or sending the personal information from the client system to at least one other network entity as requested by a first network entity. In addition, none of the portions of Goldhaber cited by the Examiner or Goldhaber as a whole teaches or enables editing personal information stored at the client system and, in particular, Goldhaber does not teach or enable separately editing the personal information for each of the other network entities selected by the user to receive the personal information as sent by the client system.

Claim 7

Claim 7 reads:

7. (Currently Amended) A method of a web server participating in a distribution of personal information of a user in a network environment, comprising:
- receiving, at a web server accessed by a user from a client system over a network, initial personal information from the user over [[a]] the network;
 - sending a request from the web server to the user requesting the user [[to]] send the initial personal information of the user to at least one other specified network entity;

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sending, with the request, an indication of a financial incentive to comply with the request; [[and]]
receiving, at the web server, a copy of the user personal information sent to the at least one other specified network entity from the user;
comparing, at the web retailer, the received copy of the user personal information with the received initial personal information; and
sending a remuneration, based on the comparison, from the web server to the user for complying at least in part with the request.

The Examiner originally rejected claim 7 on the same grounds as the rejection of claim 1. [Office Action, pp. 4, 5] Regardless of the Examiner's grounds of rejection, Applicants have amended claim 7 and Goldhaber does not teach the elements of (1) receiving, at the web server, both the initial personal information and a copy of the user personal information sent to the at least one other specified network entity from the user, (2) comparing, at the web retailer, the received copy of the user personal information with the received initial personal information, and (3) sending a remuneration, based on the comparison, from the web server to the user for complying at least in part with the request. In contrast, claim 7 is amended to teach sending a request from the web server to the client system for the client system to send the initial personal information received by the web server to at least one other network entity. In addition, claim 7 is amended to teach the web server receiving a copy of the user personal information that is sent to the other network entities, comparing the initial personal information with the copy, and sending remuneration to the client system based on the compliance with the request to send the initial personal information.

Applicants note that dependent claim 8 previously included the elements of "comparing the received copy of the user personal information with the received initial personal information" and "sending a remuneration, based on the comparison, to the user for complying at least in part with the request." The Examiner rejected claim 8 under Goldhaber, col. 12, lines 48-67, col. 15, lines 38-67, and col. 16, lines 1-11. [Office Action, p. 5] Goldhaber, col. 12, lines 48-67 reads:

Personal Data

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We keep the contact information of each member confidential. If an advertiser wants your name and address, he has to offer to buy it, and you have to agree to the price. (Furthermore, you can specify that no advertiser can resell your name without your permission.) An offer to buy you name and address might look like this:

Please accept \$2.00 for your name and address so we can send you more info.

If you accept by clicking on the coin, your name and address (from your personal data) will be forwarded to the advertiser, and \$2 will be transferred from the advertiser to you.

Contact Information--Confidential

We will never release this information. You may chose to release it, however, in response to an advertiser's offer to pay you for your name and address. There is no way that an advertiser can access this information without your case-by-case consent.

Applicants note that Goldhaber only describes an attention broker service that stores the confidential information of users and the attention broker service forwards the confidential information to advertisers only if the attention broker service receives the user's permission to forward the information. Col. 15, lines 38-67 and Col. 16, lines 1-11 of Goldhaber describe an attention broker service that stores ads and delivers each ad to users whose interest profile matches the type of ad. In addition, Col. 15, lines 38-67 and Col. 16, lines 1-11 of Goldhaber describe a software agent associated with a user's client system that interacts with the attention broker server to present a user's profile to the attention broker server. No portion of Goldhaber, however, describes the user system sending the personal information to the other network entities. In addition, no portion of Goldhaber describes the attention broker server or any other server receiving both initial personal information and a copy of the user personal information that the client system sends to other network entities. Further, no portion of Goldhaber describes the attention broker server sending the remuneration based on a comparison of the personal information initially received versus the copy of the personal information sent to the other network entity to determine if the user complied with the request to send the same personal information to the other network entity.

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Therefore, in view of the foregoing, Applicants respectfully submit Goldhaber does not teach the method of claim 7. Because Goldhaber does not teach or enable each and every element of claim 7, Goldhaber does not anticipate claim 7 and the claim 7 should be allowed.

Claims 8 and 9

Applicants respectfully assert that because Goldhaber does not anticipate claim 7, Goldhaber also does not anticipate claim 9, which is dependent upon claim 7. Claim 8 is incorporated into claim 7 and cancelled. Claim 9 is amended to reflect the amendments to claim 7 to maintain proper antecedent basis.

Claim 10

Claim 10 reads:

10.(Currently Amended) A method of participating in a distribution of personal information of a user in a network environment, comprising:
 receiving, at a network entity, personal information of the user from the user client system with an indication of a requesting network entity that requested the user send the network entity the personal information; and
 sending, from the network entity, a [[second]] remuneration to the indicated requesting network entity in response to receiving the personal information from the user client system.

The Examiner rejects claim 10 as allegedly taught and enabled by Goldhaber, col. 7, lines 11-67, col. 12, lines 49-67, col. 19, lines 21-67 and col. 20, lines 1-58. [Office Action, p. 4] Applicants respectfully assert that regardless of whether the Examiner's previous assertions are correct, Goldhaber does not teach or enable each and every element of claim 10 as amended. In particular, as previously discussed with reference to claims 1 and 7, Goldhaber does not describe a client system that stores the personal information or sends the personal information; in contrast Goldhaber merely describes an intermediary, which is either an attention broker server or software agent that stores and controls distribution of user personal information. *Goldhaber*, col. 10, lines 39-43, AUS920010168US1

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col. 7, lines 10-67, col. 19, lines 21-67, col. 20, lines 1-58. Further, because Goldhaber only describes an intermediary that stores and distributes personal information, Goldhaber does not teach a client system with the personal information, a requesting network entity that requests the client system send a second network entity the personal information, or the second network entity that sends remuneration to the requesting network entity indicated with the personal information received at the second network entity. In contrast, claim 10 is amended to teach receiving, at a network entity, personal information of the user from the user client system with an indication of a requesting network entity that requested the user send the network entity the personal information and sending, from the network entity, a remuneration to the indicated requesting network entity in response to receiving the personal information from the user client system. The specification supports the amendment throughout, and for example, in paragraph 0051. Therefore, Applicants respectfully request entry of the amendments to claim 10 which are fully supported by the specification and therefore do not add new matter. In addition, in conclusion, because Goldhaber does not teach or enable each and every element of claim 10, Applicants respectfully request withdrawal of the rejection and allowance of claim 10.

Claims 11 and 12

The Examiner rejects claims 11 and 12 under the same grounds as claim 1. [Office Action, p. 4] Applicants respectfully assert that because Goldhaber does not anticipate claim 1, Goldhaber also fails to anticipate claims 11 and 12 for the same reasons as stated with regard to claim 1. In addition, Applicants note that claim 11 does not recite the same elements as claim 1. In particular, claim 11 includes the following limitations which are not set out in claim 1: a communication device enabling communication over a network, a first memory having a set of instructions, a second memory having personal information of a user, and a processing unit executing the set of instructions in the first memory to enable receipt of a request from a first network entity through the communications device to send the personal information stored in the second memory

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to at least one other network entity. Therefore, because neither claim 1 or the rejection of claim 1 recites each of the limitations of claim 11, a rejection of claim 11 on the same grounds as claim 1 fails to show how Goldhaber teaches and enables each and every element of claim 11. In addition, Applicants respectfully assert Goldhaber does not teach or enable a data processing system comprising a processing unit executing the set of instructions in the first memory to enable receipt of a request from a first network entity through the communications device to send the personal information stored in the second memory to at least one other network entity.

Claim 14

The Examiner rejects claim 14 on the same grounds as claim 7. [Office Action, p. 4] Applicants note that claim 14 is amended to reflect the amendments to claim 7. Because amended claim 7 is not anticipated by Goldhaber, Applicants respectfully assert that amended claim 14 also is not anticipated by Goldhaber and therefore should be allowed.

Claims 15 and 16

Applicants respectfully assert that because Goldhaber does not anticipate claim 14, Goldhaber also does not anticipate claim 16, which is dependent upon claim 14. Claim 15 is incorporated into claim 14 and cancelled.

Claim 17

The Examiner rejects claim 17 as allegedly disclosed by Goldhaber, col. 7, lines 11-67, col. 12, lines 49-67, col. 19, lines 22-67 and col. 20, lines 1-58. [Office Action, p. 5] Applicants respectfully assert that regardless of whether the Examiner's previous assertions are correct, Goldhaber does not teach and enable all the elements of claim 17 and therefore claim 17 should be allowed. Applicants note that claim 17 is amended in a similar manner as claim 10. For the same reasons that Goldhaber does not teach

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and enable each and every element of claim 10, Goldhaber does not teach and enable each and every element of claim 17.

Claim 18

The Examiner rejects claim 18 under the same grounds as claim 1. [Office Action, p. 5] Applicants respectfully assert that because Goldhaber does not anticipate claim 1, Goldhaber also fails to anticipate claim 18 for the same reasons as stated with regard to claim 1. In addition, Applicants respectfully assert that claim 18 does not recite the same elements as claim 1. In particular, claim 18 teaches a computer program having computer readable instruction code means on a computer readable medium. Because neither claim 1 or the rejection of claim 1 recites the additional limitations of claim 18, a rejection of claim 18 on the same grounds as claim 1 fails to show how Goldhaber teaches each and every element of claim 1. In addition, Applicants respectfully assert that Goldhaber does not teach or enable a computer usable medium with instruction means enabling receipt of a request from a first network entity to send the stored personal information to at least one other network entity or instruction means for sending the edited personal information from the client computer system to each of the selected ones of the at least one other network entity.

Claims 20-23

The Examiner rejects claims 20-23 on the same grounds as claims 14, 15, 16, and 17, respectively. [Office Action, p. 5] First, Applicants note that claims 20 and 23 are amended in a similar manner as the amendments to claims 14 and 17, respectively. Applicants assert that because Goldhaber does not anticipate each of amended claims 14 and 17, Goldhaber also does not anticipate each of amended claims 20 and 23. Claim 21 is canceled. Claim 22 is dependent upon claim 20, which is not anticipated by Goldhaber and therefore as a dependent claim of an allowable independent claim, claim 22 should be allowed.

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Lack of Obviousness under 35 USC § 103(a)

Claims 3, 4, 13, and 19 are not obvious under Goldhaber in view of O'Neil

Claims 3, 4, 13, and 19 stand rejected under 35 USC 103(a) as being unpatentable over Goldhaber in view of O'Neil (US Patent 5,987,440). First, claims 1, 12, and 18, upon which claims 3, 4, 13, and 19 are dependent, are not anticipated by Goldhaber and therefore the dependent claims are not obvious under Goldhaber in view of O'Neil. Separately, the Examiner does not establish a prima facie case of obviousness as to claims 3, 4, 13, and 19, and therefore the claims should be allowed. Claims 3 and 4 read:

3.(Original) The method of claim 1 further comprising watermarking the edited personal information before sending the personal information.

4.(Original) The method of claim 2 further comprising:
uniquely watermarking each one of the separately edited personal information before sending each of the separately edited personal information to each selected ones of the at least one network entity.

In the rejection of claim 3, the Examiner states "Goldhaber discloses the need to prevent unauthorized release of the personal information but does not explicitly mention the use of watermarking the edited personal information before sending the personal information." [Office Action, p. 5] The Examiner cites O'Neil as "an analogous art" and argues that O'Neil discloses "the use of digital signature to track and prevent further distribution of personal information beyond a third party" in col. 6, lines 29-53 and col. 9, lines 27-55. [Office Action, p. 5] The Examiner concludes "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method taught by Goldhaber et al. with the use of digital signature as taught by O'Neil since it was known in the art that a digital signature or watermark is used to securely deliver electronic documents and information thus preventing non-authorized distribution." [Office Action, pp. 5-6]

Col. 6, lines 29-53 of O'Neil read:

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The other aspect of trusted processing, protection of data, is improved in two ways by the preferred embodiment of the present invention. First, the preferred embodiment uses state-of-the-art techniques, such as public-key cryptography, to securely store and transmit information. Public-key cryptography is discussed in more detail in a later section. These techniques assure that the data can not be deciphered if intercepted during transmission, and only the intended reader can decrypt and understand the information. The second security feature of the preferred embodiment is designed to place controls on the amount of information processed and to limit the utilization of data to recipients meeting criteria established by the user. This security feature allows the user to set rules that govern the processing and utilization of personal information. For example, one rule may state that it is acceptable to release legal history information to a user that is from the American Bar Association E-Metro Community. Another rule may state it is acceptable to utilize a home phone number by a user that is single, from a particular geographic area, and also agrees to have their home number utilized in a controlled manor. By setting sufficient rules, an individual can control the utilization of personal information by only trusted users. Additionally, the user may set transitive rules that attach to information that control electronic distributed processing of the information. Thus, when a user authorizes trusted remote processing of personal information, the information is utilized in a manner that allows the user to maintain command and control of how the information is subsequently utilized.

The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Applicants respectfully assert that the Examiner fails to prove a prima facie case of obviousness in claims 3 and 4 and therefore Applicants respectfully request withdrawal of the rejection and allowance of the claims.

Goldhaber in view of O'Neil does not teach or suggest each and every element of claims 3 and 4

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaack*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully assert that a prima facie case of obviousness is not proven because Goldhaber in view of O'Neil fails to teach or suggest all the elements of claims 3 and 4. In particular, Applicants

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respectfully assert that Goldhaber in view of O'Neil does not teach or suggest each and every element of claims 3 and 4 because O'Neil does not teach or suggest watermarking the edited personal information before sending the information to at least one other network entity.

During the interview, Applicants argued and continue to assert that O'Neil only describes use of a digital signature to encrypt data for secure transmission. *O'Neil*, col. 6, lines 29-53. Applicants asserted that a digital signature, which encrypts data for secure transmission, does not teach or suggest a digital watermark, which is data embedded in a file to identify ownership. In addition, Applicants argued during the interview and continue to assert that the terms digital signature and digital watermark have plain meanings that clearly show that applying a digital signature does not teach or suggest applying a digital watermark. Digital signature is defined as "a security mechanism used on the Internet that relies on two keys, one public and one private, that are used to encrypt messages before transmission and to decrypt them on receipt." Microsoft Computer Dictionary, 5th Edition, copyright Microsoft Corporation 2002, p. 159. Digital watermark is defined as "a unique identifier embedded in a file to deter piracy and prove file ownership and quality. Digital watermarking is often used with graphics and audio to identify the owner's rights to these works." Microsoft Computer Dictionary, 5th Edition, copyright Microsoft Corporation 2002, p. 160. Further, Applicants noted during the interview that the specification of the present application supports an interpretation of the term "watermarking" in line with the dictionary definition. *Specification*, paragraph 0045 ("...The watermark may include any type of watermarking including special textual content, background graphics, or subliminal watermarks that are invisible to the human eye. Another type of watermarking may include varying the format or content of various fields within the personal information such as changing the format of the address...")

Therefore, Applicants respectfully assert that O'Neil's system of digital signatures to encrypt data to ensure that only those recipients with a key can open the transmission does not teach the limitation of claims 3 and 4 of watermarking personal

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information by embedding unique data into the personal information so that the particular transmission of the personal information is uniquely identified.

There is no suggestion or motivation to modify Goldhaber by O'Neil to teach or suggest each and every element of claims 3 and 4

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify the references. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438, 1442 (Fed Cir. 1991). In particular, the teaching, suggestion or motivation to combine or modify the teachings of the prior art to produce the claimed invention must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art and the examiner must explicitly point to the teaching within the reference suggesting the proposed modification. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). Applicants respectfully assert that the Examiner's proposed modification of O'Neil and then Goldhaber by O'Neil is an improper use of "hindsight" occasioned only by Applicants' own teachings.

The Examiner's modification of references to teach all the elements of claims 3 and 4 would require first modifying O'Neil's description of applying digital signatures to applying digital watermarking. Neither O'Neil nor the Examiner's rejection points a motivation or suggestion for modifying digital signatures to teach digital watermarking.

Next, the Examiner's modification of references would require modifying Goldhaber's description of the attention broker system that distributes personal information to further include the modified system of O'Neil. Goldhaber does not motivate or suggest uniquely identifying a particular transmission of the personal

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information by the attention broker server. In addition, neither O'Neil nor the Examiner's rejection point to a motivation or suggestion for modifying Goldhaber's system to teach a client system that watermarks edited personal information before sending the information from the client system to the at least one other network entity.

Therefore, in view of the Examiner's rejection requiring a modification of O'Neil to teach digital watermarking and then a modification of Goldhaber to teach applying watermarking to personal information whether neither O'Neil or Goldhaber suggest or motivate these modifications, it is apparent that the rejection is only based on an improper use of "hindsight" occasioned by Applicants' own teachings. Because there is no motivation or suggestion to combine Goldhaber by O'Neil to teach each and every element of claims 3 and 4, a prima facie case of obviousness is not proven and the claims should be allowed.

Claims 13 and 19

The Examiner rejects claims 13 and 19 on the same grounds as the rejection of claim 3. [Office Action, p. 6] Applicants respectfully assert that for the same reasons that the Examiner fails to prove a prima facie case of obviousness as to claim 3, the Examiner fails to prove a prima facie case of obviousness as to claims 13 and 19.

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Conclusion

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims are respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

Respectfully submitted,

 m 2/21/06

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